

REMARKS

By this Amendment, Applicants amend claims 1-23 and add new claims 24-30. Claims 1-30 are therefore pending in this application.

In the Office Action of October 6, 2004,¹ claims 1-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,104,716 to *Crichton et al.* (“*Crichton*”). Applicants address the rejection, as well as the new claims, below.

Rejection of claims 1-23 under 35 U.S.C. § 103(a)

Applicants traverse the § 103(a) rejection of claims 1-23 because a case for *prima facie* obviousness has not been established based on *Crichton*. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied reference(s), taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

With regard to claim 1, *Crichton* fails to teach or suggest at least “determining, at the first processor, that a hairpin between the first and second processors is required for communicating with the second processor,” as currently claimed. *Crichton* describes a tunneling protocol that permits communications across firewalls using a proxy (col. 2, lines 32-35). As the Examiner

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

notes, *Crichton* discloses a “server end proxy,” a “client end proxy” and a “middle proxy,” which serves as a pass through for the server and client end proxies (col. 5, lines 9-13; Office Action “OA” at 3). Although *Crichton* describes establishing a connection between the two end proxies, which may be behind firewalls, using the middle proxy, *Crichton* does not teach or suggest the above-noted “determining” feature of claim 1. Even assuming that *Crichton*’s end proxies were consistent with the claimed first and second processors, *Crichton* does not teach or suggest that either of the end proxies determines that a hairpin between the proxies is required for communicating, as claimed (col. 5, lines 9-16). *Crichton* merely mentions that the middle proxy appears as a server to both end proxies and that the end proxies connect to the middle proxy by manual control after the middle proxy is started (col. 4, lines 42-53; col. 5, lines 1-9). In *Crichton*’s system, the client and server initiate sessions with the end proxies to bypass firewall controls, the end proxies do not determine that a hairpin is required for communications between the client and server. For at least the foregoing reasons, *Crichton* does not teach or suggest each and every feature of claim 1. As such, *prima facie* obviousness has not been established.

In addition, *prima facie* obviousness has not been established because the Office Action failed to provide a suggestion or motivation to modify *Crichton* to include the above-noted features of claim 1. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action does not show that a skilled artisan considering *Crichton*, and not having the benefit of Applicants' disclosure, would have been motivated to modify the reference in a manner resulting in Applicants' claimed combination. Applicants call attention to M.P.E.P. § 2143.01, which makes clear that: "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (citations omitted). The Office Action does not show that the cited art "suggests the desirability" of modifying *Crichton* in a manner resulting in Applicants' claimed invention. Indeed, a skilled artisan would not have been motivated to modify *Crichton* to achieve all of the features of claim 1, absent the benefit of Applicants' disclosure.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claim 1. Because *prima facie* obviousness has not been established, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Claims 2-6 and 16 depend upon base claim 1, and the § 103(a) rejection of those dependent claims should be withdrawn for at least reasons similar to those presented above in connection with claim 1.

Further, with regard to dependent claim 2, Applicants submit that the Examiner has not established inherency. In rejecting claim 2, the Examiner alleges that "providing an IP address and a first port number at the hairpin is met inherently on column 5, lines 6-8 [of *Crichton*]" (OA at 3). Applicants call attention to M.P.E.P. § 2112, which makes clear that:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient'" (emphasis added, internal citations omitted).

In addition, M.P.E.P. § 2112 states:

[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art (internal citations omitted).

The Office Action fails to provide sufficient evidence from *Crichton*, or any recourse to extrinsic evidence, that makes clear that the subject matter of claim 2 is necessarily present in the reference. The fact that *Crichton* mentions “setup information” does not evidence that the claimed “providing” features are necessarily present in *Crichton*, even if, as the Examiner alleges, an IP address and port number “qualify as set up information” (OA at 3). Further, the Office Action fails to present sufficient factual basis and technical reasoning to demonstrate inherency. Consequently, the Examiner cannot properly infer that the “providing” subject matter of claim 2 is inherently disclosed by *Crichton*.

Independent claim 7, as currently presented, recites a combination including:

receiving, at the at least one additional processor, a first request from the first processor for a hairpin, when the first processor determines that the one or more firewalls restrict the communication between the first and second processors [and]

receiving, at the at least one additional processor, a second request from the second processor for the hairpin, when the second processor determines that the one or more firewalls restrict the communication between the first and second processors.

Crichton fails to teach or suggest at least these features. As the Examiner notes, *Crichton* discloses that the client end proxy sends setup information to the middle proxy and the server end proxy also sends setup information to the middle proxy (col. 5, lines 45-60). According to the Examiner, “[t]he first processor [recited in claim 7] is represented by . . . [*Crichton*’s] client end proxy . . . [the] second processor is represented by . . . [*Crichton*’s] server end proxy and the additional processor is represented by the middle proxy” (OA at 4). Even assuming that *Crichton*’s end proxies were consistent with the claimed first and second processors and

Crichton's middle proxy were consistent with the claimed additional processor, *Crichton* does not teach or suggest the "receiving" features of claim 7. To begin with, the Examiner provides no evidence, beyond conjecture, to establish that receiving setup information is consistent with receiving a request for a hairpin. In fact, according to *Crichton*, the setup information merely includes "information [that] allows two end proxies [to] connect . . . to the same middle proxy" and "information that describes the topology of the tunnel" (col. 6, lines 47-63; col. 7, lines 41-44).

Furthermore, even if *Crichton*'s setup information were construed as a request for a hairpin (Applicants disputing that construction), *Crichton* does not teach or suggest that setup information is received from a first processor "when the first processor determines that the one or more firewalls restrict the communication between the first and second processors" and from a second processor "when the second processor determines that the one or more firewalls restrict the communication between the first and second processors," as recited in claim 7.

For at least the reasons advanced above, *Crichton* fails to disclose the "receiving" features of claim 7 and therefore fails to teach or suggest each and every claimed feature. In addition, the requisite motivation for modifying *Crichton* to include the missing features is lacking. A case for *prima facie* obviousness has thus not been established with respect to claim 7, and the § 103(a) rejection of that claim should be withdrawn. The rejection of claims 8-15 and 17-19, which depend upon claim 7, should be withdrawn as well, for at least reasons similar to those presented above in connection with 7.

Independent claim 20, as currently presented, recites a combination including:

means for determining, at the first or second processor, that the one or more firewalls restrict the communication between the first and second processors [and]

means for determining, at the at least one additional processor, whether the first and second processors mutually consent to enabling a hairpin between the first and second processors.

Although claim 20 is of different scope than claim 1, the § 103(a) rejection of claim 20 should be withdrawn for at least reasons similar to those presented above in connection with claim 1.

Although of different scope, each of independent claims 21 and 22, as currently presented, recites, *inter alia*:

code that determines, at the first or second processor, that the one or more firewalls restrict the communication between the first processor and the second processor [and]

code that determines, at the least one additional processor, whether the first and second processors mutually consent to enabling a hairpin between the first and second processors.

Although claims 21 and 22 are of different scope than claim 1, the § 103(a) rejection of those claims should be withdrawn for at least reasons similar to those presented above in connection with claim 1.

Independent claim 23, as currently presented, recites a combination including:

wherein one or more firewalls selectively may restrict the communication and the first and second processors detect the restriction [and]

means for determining whether the first and second processors mutually consent to enabling a hairpin between the first and second processors.

Although claim 23 is of different scope than claim 1, the § 103(a) rejection of claim 23 should be withdrawn for at least reasons similar to those presented above in connection with claim 1.

For at least the reasons set forth above, Applicants request withdrawal of the rejection of claims 1-23 under 35 U.S.C. § 103(a) and the timely allowance of those claims.

New claims 24-30

Each of new claims 24-28 depends (directly or indirectly) upon claim 1 and is not anticipated or rendered obvious by *Crichton* at least because of such dependency. Applicants further submit that *Crichton* fails to teach or suggest all of the additional features recited in new claims 24-28. Applicants therefore request the timely allowance of new claims 24-28.

New independent claim 29 recites a combination including:

determining, at . . . [an] originating processor, that communication to . . . [a] destination processor is restricted by one or more firewalls; [and]

determining, at the least one additional processor, whether the originating and destination processors mutually consent to enabling a hairpin between the originating and destination processors.

For at least reasons similar to those presented above in connection with claim 1, *Crichton* does not teach or suggest the above-noted features of claim 29. For at least this reason, claim 29 is not anticipated or rendered obvious by the applied art. New claim 30 is not anticipated or rendered obvious by *Crichton* at least because it depends from claim 29. Applicants further submit that *Crichton* fails to teach or suggest the additional features recited in new claims 30. Applicants therefore request the timely allowance of new claims 29 and 30.


The claimed invention is neither anticipated nor rendered obvious in view of the art cited against this application. Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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